

REMARKS/ARGUMENTS

This Response is filed concurrently with a Request for Continued Examination responsive to a Final Office Action dated January 14, 2005. Claims 1-40 and 51-63 are pending in the application. Claims 1, 21, 22, and 60 have been amended. Reconsideration and allowance of the application is respectfully requested.

Claims 21 and 60 stand rejected under 35 U.S.C. §102(e) as being anticipated by *Morimoto* (U.S. Publication No. 2002/0013774).

Independent claims 1, 21, 22, and 60, as amended, include limitations that are not taught or suggested in *Morimoto*. The trusted server of the present invention operates as an impartial intermediary to facilitate preparation and execution of a contract between the merchant and buyer systems. The trusted server of the present invention does not operate on behalf of either the buyer system or the seller system.

In contrast, *Morimoto* teaches a personal broker-agent system that operates on behalf of a buyer to obtain improved terms for products and/or services purchased over the internet. The *Morimoto* system may disrupt a transaction between a seller and purchaser in order to obtain a better deal for the purchaser. The personal broker-agent program taught in *Morimoto* operates to improve the position of the purchaser, and can operate to the detriment of the seller, e.g., by disrupting or terminating transactions between a seller and purchaser if more favorable terms can be obtained for the purchaser. See, e.g., paragraphs [0011]-[0014]. *Morimoto* fails to disclose a system that provides a trusted server operating as an impartial intermediary that does not operate on behalf of either the buyer or the seller systems. For at least these reasons, *Morimoto* fails to anticipate Applicant's claims 21 and 60.

Claims 1-15, 22-27, 33-40, 51, and 52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Morimoto*. Claims 16-19 and 28-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Morimoto* in view of *Kojima et al.* (U.S. Publication No. 2003/0078862). Claims 20 and 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Morimoto* in view of *Melchior et al.* (U.S. Publication No. 2002/0107785). Claims 53-59 stand rejected under 35 U.S.C.

§103(a) as being unpatentable over *Morimoto* in view of *Walker et al.* (U.S. Patent No. 6,064,987). Claims 61-63 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Morimoto* in view of *Quelene*. (U.S. Publication No. 2002/0038292).

To establish *prima facie* obviousness of a claimed invention, the Examiner has the burden of proving that three basic criteria are met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. All three of these criteria must be met in order to support a finding of *prima facie* obviousness of a claimed invention (see, e.g., MPEP § 2142).

Moreover, it is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be "clear and particular." *In re Dembiczaik*, 50 USPQ2d 1614 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of references, standing alone, are not evidence. *Id.*

Morimoto, alone or in combination with the other references relied on by the Examiner, fails to teach or suggest all limitations recited in Applicant's claims, as amended. As is discussed above, *Morimoto* wholly fails to teach or suggest a trusted server that operates as an impartial intermediary between a merchant system and a buyer system. In contrast, *Morimoto* specifically teaches that the personal broker-agent system operates on behalf of the buyer. For at least this reason, *Morimoto*, alone or in combination with the other references relied on by the Examiner, fails to render Applicant's rejected claims obvious.

Moreover, the asserted references, alone or in combination, fail to provide the requisite motivation to support their combination in the manner advanced by the Examiner. The teachings of *Morimoto* discourage use of a trusted server, and would motivate one skilled in the art to employ a biased agent for the benefit of only one

party to a contractual transaction. It is unclear how *Morimoto*, alone or in combination with other art references relied on by the Examiner, could provide the requisite motivation to combine the reference teachings in the manner suggested by the Examiner given the incongruous objectives of the *Morimoto* system relative to those of Applicant's claimed systems and methods. Moreover, *Morimoto*, alone or in combination with other art references relied on by the Examiner, fails to provide a reasonable expectation of success, given the considerations discussed above.

For at least these reasons, the asserted combination of *Morimoto*, alone or in combination with *Kojima*, *Melchior*, *Walker* or *Quelene*, fails to render Applicant's subject matter of claims 1-20, 22-40, and 53-59 and 61-63 obvious.

Without acquiescing to the Examiner's characterization of the asserted references as they have been applied to Applicant's rejected dependent claims, Applicant believes it unnecessary to address the specific grounds for rejection in view of the clear grounds for patentability of the claims from which they respectively depend. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." M.P.E.P. §2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicant, however, reserves the right to address these rejections should the Examiner maintain the rejection of the base claims, notwithstanding Applicant's remarks presented hereinabove.

It is believed that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if there are any questions regarding the above new claims or if prosecution of this application may be assisted thereby.

Authorization is also hereby provided to charge/credit deposit account No. 50-0996 (NOKV.008PA) for any under/over payment in connection with the instant Office Action Response.

It is believed that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicant's Representatives, at (651) 686-6633 x 111, if there are any questions regarding the above amendments or remarks or if prosecution of this application may be assisted thereby.

Respectfully submitted,

Date: April 14, 2005

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